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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/540,632

Filing Date: June 23, 2005

Appellant(s): SUDA ET AL.

Christopher J. Korff
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 4/01/2010 appealing from the Office action
mailed 11/23/2009.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

Claims 1 and 7-12.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the

subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

WITHDRAWN REJECTIONS

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner.

The rejection of claims 1 and 7-12 under 35 U.S.C. 112, first paragraph as failing to comply with the written description.

The Examiner finds appellants argument that the covering rate range of 5-50% is supported by Tables 8 and 9 of the specification. incomplete sentence

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

Declaration of Yuji Iwashashi, 5 December 2008

Certification Statement of Kanako Ohtsuka, 20 August 2009

Certified Translation of Priority Document, PCT/JP2003/16952

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 7-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakane et al. (US 5,122,418) in combination with Kobayashi et al. (US 5,928,660).

Applicant's Invention

Applicant claims a complex powder comprising a lipophilic base powder and zinc oxide, where the surface of lipophilic base powder is covered with zinc oxide and an oil component wherein said complex powder is dispersed and swelled in said oil component, the zinc oxide covers from 1-90% of the total surface area of said lipophilic base powder and said lipophilic base is selected from silicon resin, silicone rubber and silicone resin-covered silicone rubber. Claim 7 specifies the oil component comprises silicone oil. Claim 8 specifies the amount of powder is 1-50% by weight. Claim 9 specifies the composition is an emulsion.

Applicants claim a method of treating rough skin comprising applying the composition to the skin.

Applicants claim a method of treating sensitive skin comprising applying the composition to sensitive skin.

Determination of the scope and the content of the prior art

(MPEP 2141.01)

Nakane et al. teach a composition for protecting skin from the sun comprising; a complex powder including lipophilic base powder and zinc oxide, where the surface of lipophilic base powder is covered with zinc oxide; and an oil component (Example 25). The composition contains 30% zinc oxide covered polymethyl methacrylate (7%) in the form of an emulsion in silicone oil (dimethylpolysiloxane 10%). The lipophilic base powder is dispersed in the oil component (column 26, lines 12-21).

Ascertainment of the difference between the prior art and the claims

(MPEP 2141.02)

Nakane et al. do not teach a composition comprising the lipophilic base powder selected from the group consisting of silicone resin, silicone rubber and silicone resin-covered-silicone rubber. It is for this reason that Kobayashi et al. is combined.

Kobayashi et al. teach a cosmetic comprising powdered silicone rubber which has a good feeling and spreading characteristics on the skin (abstract). Using an aqueous suspension of a powdered silicon rubber containing a non-crosslinked oil causes a softening feeling of the skin and improves cosmetic durability wherein the oil

impregnates(swells) the powdered silicone rubber (column 3, lines 8-23). It is desirable to have the content of the non-cross-linked oil in the powdered silicone rubber 80% or less, with a content of 50% or less being preferable (column 4, lines 56-63). A powdered silicone rubber whose surface is covered by a fine inorganic powder shows good stability (column 4, lines 64-67). Inorganic powders include zinc oxide (column 5, lines 9, and 21-41).

Finding of prima facie obviousness

Rationale and Motivation (MPEP 2142-2143)

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Nakane et al. and Kobayashi et al. to further utilize silicone rubber as the base powder. One would have been motivated to use silicon rubber because Kobayashi et al. teach that cosmetics comprising silicone rubber cause softening feeling to the skin and improves cosmetic durability. In view of *KSR International Co. v. Teleflex Inc.*, 550 U.S.--, 82 USPQ2d 1385 (2007), substitution of one known equivalent element for another to obtain predictable results is prima facie obvious. Therefore, one of ordinary skill in the art would have expected that substituting silicone rubber in place of polymethyl methacrylate would yield a cosmetic composition with improved feeling to the skin and durability.

(10) Response to Argument

Appellants argue that 40% titanium oxide covered spherical cellulose means 40% by weight in the complex powder based on the way the composition is made. The

Examiner is not persuaded by this interpretation because the weight percentages in the examples of Nakane have not been equated to the surface area covering percentages. Nakane specifically teaches 30% zinc oxide covered polymethyl methacrylate resin comprises 7% of the composition (Example 25). Furthermore, Appellant was previously directed to Example 8, wherein the composition comprises (1) titanium dioxide and (2) 35% titanium oxide covered spherical nylon powder. It is clear that these are two distinctly different compounds utilized in the formulation at a relative percentage of 6% and 7%, respectively. The fact that Nakane clearly specifies that (2) is 35% covered with titanium dioxide supports the fact that the surface of the Nylon powder is coated at a specific rate. Hence, Nakane explicitly teaches that 40% titanium oxide covered is not the same as the weight percentage based on the way the composition is made.

Next, Appellants argue that even though the term substantially completely covered is not defined in Nakane, it is readily discernible by a skilled artisan to be much higher than 5-50%. The Examiner is not persuaded by this argument because Nakane fails to teach a specific range, hence the term has been given its broadest reasonable interpretation. Since Example 25 discloses 30% covered polymethyl methacrylate resin, it is the Examiners position that 30% covered zinc oxide encompasses the meaning of "substantially completely" covered.

Appellants finally argue that Nakane fails to teach a silicone resin, silicone rubber or silicon resin-covered silicon rubber which is swellable in oil and Kobayashi fails to teach covering powdered silicone rubber with zinc oxide at a covering rate of 5-50%. In response to applicant's arguments against the references individually, one cannot show

nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Nakane was combined with Kobayashi to show that substituting lipophilic powdered silicone rubber in place of polymethyl methacrylate resin is at least prima facie obvious. Kobayashi et al. teach that cosmetics comprising silicone rubber cause softening feeling to the skin and improve cosmetic durability. In view of KSR International Co. v. Teleflex Inc., 550 U.S.–, 82 USPQ2d 1385 (2007), substitution of one known equivalent element for another to obtain predictable results is prima facie obvious. Therefore, one of ordinary skill in the art would have expected that substituting silicone rubber in place of polymethyl methacrylate would yield a cosmetic composition with improved feeling to the skin and durability (column 3, lines 8-13).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Johann R. Richter/

Supervisory Patent Examiner, Art Unit 1616

Conferees:

/Danielle Sullivan/

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Art Unit: 1616

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Examiner, Art Unit 1616

/SREENI PADMANABHAN/

Supervisory Patent Examiner, Art Unit 1627